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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/817,251	03/27/2001	Hisao Hiramatsu	Q63803	8044
7590 02/14/2005 SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC 2100 Pennsylvania Avenue, N.W. Washington, DC 20037			EXAMINER SOOHOO, TONY GLEN	
			ART UNIT 1723	PAPER NUMBER

DATE MAILED: 02/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/817,251

Applicant(s)

HIRAMATSU ET AL.

Examiner

Tony G. Soohoo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 11-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 11-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-5, 7, are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 62184357 (JP '357 cited on PTO 1449) in view of Qureshi et al 5383372 (newly cited).

JP '357 teaches a method of mixing including

PURPOSE: To easily and quickly stir liquid with an automatic clinical specimen inspecting apparatus, etc., by alternately repeating a process for lowering a pipette to hold the top end thereof under the liquid surface and sucking the liquid and process for rising the pipette to hold the top end above the liquid surface and discharging the liquid.

CONSTITUTION: The liquid A is put into the bottom of a vessel 4 and in this state the pipette sucking the liquid B is inserted into the vessel 4 and discharges the liquid B therein. The liquid A and the liquid B are mixed but are not yet thoroughly stirred. The top end of the pipette 1 is then lowered and is immersed under the liquid surface of the mixed liquid A+B to suck the specified amt. thereof, then the pipette 1 is raised while the mixed liquid is held sucked into the top end thereof and the liquid in the pipette 1 is discharged above the liquid surface of the mixed liquid existing in the vessel 4. The liquids in the vessel 4 are thus physically stirred by repeating the lowering-suction and rising- discharge of the pipette 1 with the liquid surface in the vessel as a boundary. (COPYRIGHT: (C)1987,JPO&Japio)

The JP '357 reference discloses all of the recited subject matter as defined within the scope of the claims with the exception of moving the pipette to a different horizontal position (translate) of the nozzle so that when the fluid is discharged, discharged fluid is discharged directly into the liquid in the container at a discharging position horizontally different from the sucking position. It is also noted however that the JP '357 teaching does not require the nozzle to be in the same horizontal position to perform the method.

The reference to Qureshi et al teaches that a pipette may be hand held for the suction and dispensing of a liquid (and also discharged with air blown out if desired) for amore precise measurement and delivery of liquids.

In view of the teaching of Qureshi that one may use a hand held pipette to suck and dispense liquids, it is deemed that it would have been obvious to one of ordinary skill in the art to modify the step of JP '357 with a use of a handheld pipette so that mechanical equipment costs are minimized when using the mixing method of JP'357. Additionally, it is noted that when a hand held device is used, the process of mixing as taught by the JP '357 would have inherent variations in the horizontal and vertical positioning of the hand held pipette nozzle by the user when performing the suction, lifting, and discharge, since the human hand may not readily replicate an exact positioning of a machine.

With regards to claim 7 , it is deemed that it would have been obvious to one of ordinary skill in the art to substitute for the liquid material in the method and in particular manipulate blood as the liquid to me stirred whereby, it is old and well known of the

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desire to mix blood in certain instances in the medical field. It has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

3. Claims 6, 11-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 62184357 (JP '357 cited on PTO 1449) in view of Qureshi et al 5383372 (newly cited) as applied to claim 1 above, and further in view of Makino et al 5555767 (previously cited).

JP 62184357 (JP '357 cited on PTO 1449) in view of Qureshi et al 5383372 (newly cited) discloses all of the recited subject matter as defined within the scope of the claims with the exception of discharging the liquid toward an inclined wall of container.

The Makino (et al) reference discloses that a mixing method of blood may be used with a container having straight sides as seen in figures 1-2 or with a container having inclined sides 3-5. Additionally, the Makino reference teaches that one may place a nozzle in a position near and directed toward the incline when dispensing the fluid into the container as seen in figure 3B, 3D, 4B, 4D, column 10, lines 53-61, 66 through column 11, line 3, and further teaches that a container with an inclined wall provides good string and mixing performance, column 11, lines 24-32.

In view of the teaching of Makino, it is deemed that it would have been obvious to one of ordinary skill in the art to provide for the method of JP '357 as modified by

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Qureshi et al with the use of a container with an inclined wall and further dispense the fluid toward the incline so as to produce good stirring and mixing performance with the discharge of the fluid into the main liquid sample.

With regards to claim 17, it is deemed that it would have been obvious to one of ordinary skill in the art to substitute for the liquid material in the method and in particular manipulate blood as the liquid to be stirred whereby, it is old and well known of the desire to mix blood in certain instances in the medical field. It has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Response to Arguments

4. Applicant's arguments filed 11-22-2004 have been fully considered but they are not persuasive.

5. Applicant argues with regards to the combination of the references of JP 62184357 (JP '357) in view of Qureshi et al 5383372 (Qureshi) that the combination does not show an inherent variation of the horizontal and vertical positioning of the nozzle if performed by hand since this has not been disclosed or suggested in the JP '357 reference, see arguments page 8, last paragraph. In response, applicant has not shown sufficient convincing evidence to the examiner that the human hand may produce an exact positioning so that there are no variation to the horizontal and vertical

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position of a pipette when positioned by hand. Thus applicants sole argument to the JP '357 is non-persuasive.

Applicant further argues on page 9 that the references in further view of Makino fails to disclose or suggest either separately or in combination the step of discharging the liquid directly into the liquid or toward the inclination at a horizontal different position of the sucking position to stir the liquid. Applicant alleges that the Makino although the Makino reference shows a movement of the pipe and a repeated suction and discharge step, there is no teaching to move the pipette containing the liquid from the sucking position to another position, see page 10 of applicant's arguments. In response, the application of the Makino reference is a teaching of the advantages of dispensing a nozzle in a position near and directed toward the incline when dispensing the fluid into the container as seen in figure 3B, 3D, 4B, 4D, column 10, lines 53-61, 66 through column 11, line 3, and further teaches that a container with an inclined wall provides good string and mixing performance, column 11, lines 24-32. Following from such a teaching, it has been concluded as discussed in the rejection above to obvious to further modify the manipulative steps of JP 62184357 (JP '357) in view of Qureshi et al 5383372.

6. Applicant's piece meal analysis of the Makino reference has not taken into consideration combination of JP 62184357 (JP '357) in view of Qureshi et al 5383372 taken together as a whole. Thus applicants sole argument to the Makino is non-persuasive.

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7. Applicants declaration under 37 CFR 1.132 has been considered. However the issue at hand is not merely to the Makino reference itself, thus any unexpected results or advantages over the sole Makino reference is deemed unpersuasive.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kressirer 5365798 is cited as an example whereby it is known to move a pipette in a horizontal translation for mixing, column 2, lines 15-18. The reference to Pursell establishes knowledge in the art to use a hand held pipette to permit mixing of a sample, column 1, lines 30-32, and column 3, lines 29-34. The reference to Rainin et al 6254832 teaches a powered hand held pipette which has a mix mode operation, column 21, lines 30-55.

9. ***No patentable subject matter has been indicated.***

10. ***ALL claims are rejected.***

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any


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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tony G. Soohoo whose telephone number is (571) 272 1147. The examiner can normally be reached on 7:00 AM - 5:00 PM, Tues. - Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda Walker can be reached on 571-272-1151. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Tony G Soohoo
Primary Examiner
Art Unit 1723
